

REMARKS

The Office Action dated December 28, 2006 has been received and carefully studied.

The Examiner maintains the rejection of claims 1-4, 6 and 19-22 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, as obvious over Kopaciewicz, U.S. Patent No. 6,048,457. The Examiner also rejects claims 5 and 23 as being unpatentable of Kopaciewicz in view of Wheeler, U.S. Publication No. 2003/01920260.

The rejections are respectfully traversed.

It is well settled that anticipation by inherency requires that the missing element is necessarily present in the reference. *Schering Corp. v. Geneva Pharmaceuticals, Inc.*, 67 U.S.P.Q.2d 1664 (Fed. Cir. 2003); *Continental Can Co. USA, Inc. v. Monsanto Co.*, 20 U.S.P.Q.2d 1746 (Fed. Cir. 1991); *In re Oelrich*, 666 F.2d 578, 581-82, 212 U.S.P.Q. 323, 326 (CCPA 1981) ("To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may

result from a given set of circumstances is not sufficient.'"). That a pipette tip "could" enter the bath in Kopaciewicz in a horizontal orientation is insufficient to establish anticipation, since other orientations are possible (and indeed were used). Accordingly, Applicants respectfully submit that the rejection for anticipation under §102(b) is improper as a matter of law, and should be withdrawn.

With regard to the obviousness rejections, it is also well settled that a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). The Examiner reasons that one would immerse the housing in the bath such that the quenching bath enters the openings simultaneously in order to provide the same quenching times to as much of the casting solution as possible, so that "a uniform, predictable structure is provided in the housing." However, no basis is given, and none is seen, for concluding that a uniform, predictable structure in the housing would be formed by carrying out the immersion as the Examiner suggests. In fact, the simultaneous entry of the quenching bath into the openings of the housing means that solvent exchange is controlled by diffusion, and the resulting composite structure that is

formed in the housing is much more dense than the devices of Kopaciewicz where single-sided quenching is used. This is clearly demonstrated in the Examples of the present application, and is nowhere disclosed or suggested in the cited art. More dense structures means more binding sites per unit volume, allowing more efficient sample capture compared to the relatively open structure produced by the single-sided quench of Kopaciewicz. However, this comes at the expense of lower permeability. This lower permeability makes it use on a pipettor impractical. The surprising and unexpected finding of more dense structure formation was unknown at the time of Kopaciewicz, and there is nothing in the cited art that would motivate the skilled artisan to carry out the quenching of Kopaciewicz in the manner now claimed.

Reconsideration and allowance are respectfully requested in view of the foregoing.

Respectfully submitted,


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